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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,323	06/02/2000	Robert Andrew Adamany	36968/185857	6460

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EXAMINER	
NGUYEN, DUC M	
ART UNIT	PAPER NUMBER
2682	

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/586,323

Applicant(s)
Adamany et al

Examiner
Duc Nguyen

Art Unit
2682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 9, 10 6) ☐ Other:

Art Unit: 2682

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 6/27/00 and 8/4/00 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.
2. The references listed in the information disclosure statements submitted 6/2/00, 12/1/00 and 2/13/02 have been considered by the examiner (see attached PTO-1449).

Specification

3. Claim 5 is objected to because of the following informalities:

It appears that a portion of the specifications's descriptions is erroneously inserted or pasted into the claim starting from line 20 of page 25 to line 18 of page 26, which is "The present invention includesobjects". Accordingly, these descriptions should be deleted from the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 2682

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by **Amin et al** (EP Pub. Number **EP 0,788,287**).

Regarding claim 1, **Amin** discloses a roaming authorization system, comprising

- carry out a registration of the wireless unit in the visited system (roaming MSC-V)

including validation of the wireless unit (MIN/ESN and roaming validation) with a home system (HLR) of the wireless unit (see col. 2, line 37 - col. 3, line 11);

- implementing, in response to the registration, a denial of originating communication service to the wireless unit (see registration denial, col. 3, lines 5-11).

Regarding claim 12, it is rejected for the same reason as set forth in claim 11 above. In addition, **Amin** discloses that in response to a positive verification of identification information received from the wireless unit, providing the originating communication service to the wireless unit (see col. 3, lines 21-23);

Regarding claims 13-14, they are rejected for the same reason as set forth in claim 11 above. In addition, **Amin** discloses

- in response to a call attempt, providing an announcement to the wireless unit (see col. 3, lines 16-21);

- wherein the announcement comprises an instruction to the wireless unit to dial a code and provide identification information (see col. 3, lines 19-21 and col. 8, line 51 - col. 9, line 13).

Art Unit: 2682

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **1-2, 5-6** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Amin**.

Regarding claim **1**, **Amin** discloses a roaming authorization system, wherein after successful registration, an authentication process is performed by the MSC-V for verifying identification information of the wireless device before providing originating communication service to the wireless unit (see col. 2, line 37 - col. 3, line 23 and col. 8, line 7 - col. 9, line 13), which differs from the claimed limitations in that the call set up is held and/or delayed during the verification process rather than activating and removing a denial service as claimed. However, with the broadest reasonable interpretation and in light of the specification (i.e, see Fig. 2), the holding state or delaying state in **Amin** could be interpreted as a denial state as claimed because both of them are used to achieve the same subject matter (prevent fraudulent use of a wireless roaming in a visited system) and the same solution (denying originating service to the wireless unit after the registration until the wireless unit provides a positive identification information). Therefore, the claimed limitations are made obvious by **Amin** for denying originating service to the wireless unit after the registration until the wireless unit provides a positive identification information (see col. 3, lines .

Art Unit: 2682

Regarding claim **2**, it is rejected for the same reason as set forth in claim **1** above. In addition, it is clear that **Amin** implicitly discloses the step of updating and providing service as claimed (see col. 6, lines 18-47, col. 9, lines 26-33).

Regarding claim **5**, it is rejected for the same reason as set forth in claim **1** above. In addition, **Amin** discloses the step of providing an announcement as claimed (see col. 3, lines 16-21).

Regarding claim **6**, it is rejected for the same reason as set forth in claim **1** above. In addition, **Amin** discloses the step of dial the code and provide identification information as claimed (see col. 3, lines 19-21 and col. 8, line 51 - col. 9, line 13).

8. Claims **3-4, 7-10** are rejected under 35 U.S.C. 103(a) as being unpatentable by in view of **Marchand et al** (PCT Pub. Number **WO 97/26769**).

Regarding claim **7**, **Amin** discloses all the claimed limitations, see claim **1** above, except for the MSC to recognize the code as a feature request message comprising the identification information. However, in an analogous art, **Marchand** discloses a system for reducing fraud in a cellular communication system, wherein a feature request comprising identification information is used by a roaming user for fraud reduction (see col. 10, line 27 - col. 11, line 27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of **Marchand** to **Amin** to provide the code as a feature request message as claimed, for reducing fraud by changing service profiles according to the roaming area.

Art Unit: 2682

Regarding claims 3-4, they are rejected for the same reason as set forth in claim 7 above. In addition, **Amin** as modified would disclose the identification information comprises a PIN (see **Marchand**, col. 11, lines 1-27). Further, since using a centralized authentication center (read on an “international gateway” as claimed) for fraud prevention/detection is known in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of **Marchand** and **Amin** to use an international gateway for performing the verification process as claimed, for fraud prevention or detection.

Regarding claims 8-9, they are rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Amin** implicitly discloses the step of updating and providing service as claimed (see col. 6, lines 18-47, col. 9, lines 26-33).

Regarding claim 10, it is rejected for the same reason as set forth in claim 1 above. In addition, **Amin** discloses the step of dial the code and provide identification information as claimed (see col. 3, lines 19-21 and col. 8, line 51 - col. 9, line 13).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Suzuki** (US Patent Number 6,041,231), Mobile communication system with roaming function.

- **Ryan, Jr. et al** (US Patent Number 5,884,158), Cellular telephone authentication system using a digital certificate.

Art Unit: 2682

- **Daniels** (US Patent Number 6,058,301), Cellular fraud prevention using selective roaming.

- **Nakasu et al** (US Patent Number 6,301,472), Portable telephone system.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-Thursday (9:00 AM - 5:00 PM). Or to Vivian Chin (Supervisor) whose telephone number is (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen

Jan 25, 2003

